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10/575,424	04/10/2006	Yang Peng	CN 030035	3752
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EXAMINER				
POPHAM, JEFFREY D				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/575,424

**Applicant(s)**

PENG ET AL.

**Examiner**

JEFFREY D. POPHAM

**Art Unit**

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-16 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 10 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)  
3) ☐ Information Disclosure Statement(s) (PTO/CIS)  
4) ☐ Interview Summary (PTO-413)  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date \_\_\_\_\_

***Remarks***

Claims 1-16 are pending.

***Claim Objections***

1. Claims 2, 3, 6, 7, 12, 13, 15, and 16 are objected to because of the following informalities:

In addition to the 112 and 101 rejections provided below, the claims have some awkward wording that could be easily clarified. Claim 2, for example states "The optical disk according to claim 1, wherein the public key being stored in the BCAs zone of the optical disk." Disregarding the issues rejected under 112 and 101, stating "wherein the public key being stored" is misleading. In order for such wording to work in the claim, there would need to be additional information at the end, such as "wherein the public key being stored in the BCAs zone of the optical disk is used for decrypting data" (with reference to such a public key already being stored in the BCAs zone in a previous limitation or claim). For purposes of prior art rejection, "wherein the public key being stored" has been construed as "wherein the public key is stored". Claims 2, 6, 7, 12, 13, and 16 have corresponding issues.

Claim 15 recites "An optical disk, used to realize playing by being connected with the network server". Once again, disregarding the 112 and 101 issues discussed below, it is unclear how one could connect a disk to a server. For purposes of prior art rejection, this limitation has been construed as referring to data stored on the disk being used in conjunction with data on a server.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There are many issues in claims 1-16 that make it difficult to discern precisely what is being claimed. What follows are examples of the 112 issues of the claims. Keep in mind, this is not an exhaustive list, and a complete response must include corrections for all such issues.

Nearly every claim has an antecedent basis issue, examples of which follow. Claim 1 recites "the downloaded content", which has not been seen previously in the claim. For purposes of prior art rejection, "the downloaded content" has been construed as "downloaded content". Claim 2 recites "the BCAs zone", which has not been previously seen in the claims. For purposes of prior art rejection, this has been construed as "a BCA zone" (referring to burst cutting area). Claim 3 recites "the media content zone" and "this laser disk", neither of which has been previously seen in the claims. For purposes of prior art rejection, "the media content zone" and "this laser disk" have been construed as "a media content zone" and "the optical disk", respectively. Claim 4 recites "a reading-out means for reading-out the content and the

public key of the optical disk" before any discussion of content, a public key, or an optical disk. For purposes of prior art rejection, this limitation has been construed as "a reading-out means for reading out content and a public key of an optical disk". As noted above, these are only examples and there are many other antecedent basis issues throughout the claims.

Claims 5 and 9 refer to integrity of downloaded content, and either executing or not executing the content based on whether such content is integral. It appears as though this "integrity" is referring to integrity of the content, such that an integrity check will be performed so it can be determined whether or not the data was properly received. For purposes of prior art rejection, integrity has been construed integrity, and being integral or not being integral correspond to passing the integrity check (data is correct) and failing the integrity check (there are errors in the data), respectively.

Claim 9 refers to "the content" and "the detected content", which is unclear as to which of the downloaded/related content or the content read the disk they refer to. Additionally noted is that "the content" as it stands refers to "the content" of claim 8 and not the downloaded content, but appears as though it should refer to "the downloaded content". For purposes of prior art rejection, both "the content" and "the detected content" in claim 9 have been construed as "the downloaded content".

Claims 10 and 11 refer to verification and authentication of the content as being separate, while claim 8 from which they depend, recites the verification and authentication as a single step. One step of the method of claim 8 is "verifying whether the downloaded content is authenticated...". One can see from that limitation that

verification and authentication are a single atomic entity. Claim 10, however, recites that "the downloaded content will be refused to operate if the verified downloaded content is not authenticated." It is impossible for the content to be verified and not authentic, however, due to the verification being the authentication. Claim 11 has the same issue. For purposes of prior art invention, claims 10 and 11 have been construed as having "the downloaded content" in place of "the verified downloaded content".

Claims 7 and 13 refer to the application program being "the JAVA language application program". It appears as though this is merely awkward wording attempting to claim that the program is written in Java. However, reference to "the JAVA language program" before such program is introduced in the claims or "the JAVA language" before such a language is introduced in the claims produces an antecedent basis issue. For purposes of prior art rejection, "the downloaded application program being the JAVA language application program" has been construed as "the downloaded application program is a Java language application program" in both claims 7 and 13.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-7 and 14-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-3 and 14-16 are directed to optical disks. A medium such as an optical disk is not a process, machine, manufacture, nor a composition of matter, and is therefore, non-statutory. Claim 4

recites an optical disk player comprising means. These means, however, are not explicitly physical components. As seen in figure 3, and page 7 of the application's specification, the detecting and authenticating (verifying) modules (means) can be stored in ROM, and therefore, may be purely software. The network/web interface is not clearly described in the specification, but is not explicitly a hardware/physical component, and appears as though it could be purely software (such as a web browser). Therefore, claims 4-7 are systems of software, per se, and fail to fall within a statutory category of invention.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 4, 8, and 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Uranaka (U.S. Patent 6,470,085).

Regarding Claim 1,

Uranaka discloses an optical disk, used to play in coordination with downloaded content, comprising a public key which is used to verify whether the downloaded content is authenticated (Figures 2 and 4; Column 5, lines 20-42; Column 5, line 58 to Column 6, line 5; and Column 15, lines 57-67).

Regarding Claim 2,

Uranaka discloses that the public key is stored in a BCA zone of the optical disk (Figures 2 and 4; Column 5, lines 40-42; Column 5, line 58 to Column 6, line 5; and Column 8, lines 34-41).

Regarding Claim 4,

Uranaka discloses an optical disk player comprising:

A reading out means for reading out content and a public key of an optical disk (Column 6, lines 42-54; Column 7, lines 19-33; Column 8, lines 34-41; and Column 12, lines 12-15);

A network interface for receiving related downloaded content (Column 6, lines 42-58; Column 9, lines 30-46; and Column 9, line 61 to Column 10, line 20); and

A verifying means for verifying whether the related downloaded content is authenticated according to the public key read out from the optical disk (Column 15, lines 57-67).

Regarding Claim 8,

Uranaka discloses a playing method, comprising:

Reading out content and a public key of an optical disk (Column 6, lines 42-54; Column 7, lines 19-33; Column 8, lines 34-41; and Column 12, lines 12-15);

Downloading related content (Column 6, lines 42-58; Column 9, lines 30-46; and Column 9, line 61 to Column 10, line 20); and



Verifying whether the downloaded content is authenticated according to the public key that was read out from the optical disk, in order to confirm whether the downloaded content will be operated (Column 15, lines 57-67).

Regarding Claim 14,

Uranaka discloses an optical disk, used to play in coordination with downloaded content, comprising a part to verify whether the downloaded content is authenticated (Figures 2 and 4; Column 5, lines 20-42; Column 5, line 58 to Column 6, line 5; and Column 15, lines 57-67).

Regarding Claim 15,

Uranaka discloses an optical disk, used to realize playing by being connected with a network server, comprising a part used to verify a playing permission of the optical disk in coordination with network information (Figures 2 and 4; Column 5, lines 20-42; Column 5, line 58 to Column 6, line 5; and Column 15, lines 57-67).

Regarding Claim 16,

Uranaka discloses that the part is a public key stored in the optical disk (Figures 2 and 4; Column 5, lines 20-42; Column 5, line 58 to Column 6, line 5; and Column 15, lines 57-67).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uranaka in view of Ryan (U.S. Patent 5,754,648).

Uranaka does not appear to explicitly disclose that the public key is stored in a media content zone of the optical disk.

Ryan, however, discloses that the public key is stored in a media content zone of the optical disk (Column 3, lines 47-67; and Column 8, lines 31-37). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the media security and tracking system of Ryan into the content usage control system of Uranaka in order to allow the system to provide additional authentication and authorization steps such that a device can ensure that both the disk and device are authentic and authorized for use with each other by using data stored on the optical disk itself and data stored on a magnetic track attached to the disk, thus decreasing the chance of unauthorized uses thereof, and/or to provide the ability to track use of the media.

6. Claims 5 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uranaka in view of Collins (U.S. Patent Application Publication 2002/0073316).

Regarding Claim 5,

Uranaka does not appear to explicitly disclose a detecting means for detecting the integrity of the content, the verification will not be executed if the detected content is not integral.

Collins, however, discloses a detecting means for detecting the integrity of the content, the verification will not be executed if the detected content is not integral (Paragraphs 73-76). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the content authentication and access system of Collins into the content usage control system of Uranaka in order to allow the system to detect when errors in the data have occurred, such that data will errors will not be allowed to be processed and only correct data will be processed, and/or to ensure that the data is authentic before allowing it to proceed, thereby increasing security of the system by ensuring both integrity and authenticity of the content.

Regarding Claim 9,

Uranaka does not appear to explicitly disclose detecting the integrity of the content to confirm whether the content is integral, further processing the content if the content is integral, and not further processing the content if the content is not integral.

Collins, however, discloses detecting the integrity of the content to confirm whether the content is integral, the verification step will not be executed if the content is not integral; and the verification step will be

executed if the content is integral (Paragraphs 73-77). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the content authentication and access system of Collins into the content usage control system of Uranaka in order to allow the system to detect when errors in the data have occurred, such that data will errors will not be allowed to be processed and only correct data will be processed, and/or to ensure that the data is authentic before allowing it to proceed, thereby increasing security of the system by ensuring both integrity and authenticity of the content.

Regarding Claim 10,

Uranaka discloses verifying whether the downloaded content is authentic (Column 15, lines 57-67) and, inherent in such verification is halting operation of/on the content if such authentication fails, but does not explicitly disclose such.

Collins, however, discloses that the content will be refused to operate if the downloaded content is not authenticated (Paragraphs 77-78). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the content authentication and access system of Collins into the content usage control system of Uranaka in order to allow the system to detect when errors in the data have occurred, such that data will errors will not be allowed to be processed and only correct data will be processed, and/or to ensure that the data is

authentic before allowing it to proceed, thereby increasing security of the system by ensuring both integrity and authenticity of the content.

Regarding Claim 11,

Uranaka discloses verifying whether the downloaded content is authentic (Column 15, lines 57-67) and, inherent in such verification is proceeding with operation of/on the content if such authentication succeeds, but does not explicitly disclose such.

Collins, however, discloses that the content will be operated if the downloaded content is authenticated (Paragraphs 77-78). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the content authentication and access system of Collins into the content usage control system of Uranaka in order to allow the system to detect when errors in the data have occurred, such that data will errors will not be allowed to be processed and only correct data will be processed, and/or to ensure that the data is authentic before allowing it to proceed, thereby increasing security of the system by ensuring both integrity and authenticity of the content.

7. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uranaka in view of Parks (U.S. Patent Application Publication 2003/0195855).

Regarding Claim 6,

Uranaka does not explicitly disclose that the downloaded content is an application program.

Parks, however, discloses that the downloaded content is an application program (Paragraphs 184-185 and 188). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the digital rights management system of Parks into the content usage control system of Uranaka in order to ensure that the system is relatively current and can be trusted, such that content cannot be decrypted and used unless and until the entity that performs rights evaluation and decryption (the black box) is up-to-date, thereby increasing security of the system.

Regarding Claim 12,

Uranaka does not explicitly disclose that the downloaded content is an application program.

Parks, however, discloses that the downloaded content is an application program (Paragraphs 184-185 and 188). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the digital rights management system of Parks into the content usage control system of Uranaka in order to ensure that the system is relatively current and can be trusted, such that content cannot be decrypted and used unless and until the entity that performs rights

evaluation and decryption (the black box) is up-to-date, thereby increasing security of the system.

8. Claims 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uranaka in view of Parks, further in view of Sun (Sun Microsystems, "The Java™ Language: An Overview", pp. 1-7, 1995 (no date on the article itself, but the page was archived on June 24, 2001), obtained from <http://web.archive.org/web/20010624032205/java.sun.com/docs/overviews/java/java-overview-1.html>).

Regarding Claim 7,

Uranaka as modified by Parks does not explicitly disclose that the downloaded application program is a Java language application program.

Sun, however, discloses that the downloaded application program is a Java language application program (Pages 1-7). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the programming language of Sun into the content usage control system of Uranaka as modified by Parks in order to create such application programs to be robust, secure, and portable, such that they can be used on many different platforms and computers.

Regarding Claim 13,

Uranaka as modified by Parks does not explicitly disclose that the downloaded application program is a Java language application program.

Sun, however, discloses that the downloaded application program is a Java language application program (Pages 1-7). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the programming language of Sun into the content usage control system of Uranaka as modified by Parks in order to create such application programs to be robust, secure, and portable, such that they can be used on many different platforms and computers.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY D. POPHAM whose telephone number is (571)272-7215. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571)272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeffrey D Popham  
Examiner  
Art Unit 2137

/Jeffrey D Popham/  
Examiner, Art Unit 2137

/Emmanuel L. Moise/  
Supervisory Patent Examiner, Art Unit 2137